Paper No. 10
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Diebolt International Inc.

Serial No. 74/714,390

William Francis of Barnes, Kisselle, Raisch, Choate, Whittemore & Hulbert, P.C. for Diebolt International, Inc.

Thomas Wellington, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Sams, Cissel, and Hairston, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 11, 1995, applicant filed the above-referenced application to register the mark "GOLD GUARANTEE" on the Principal Register for "nitrogen gas springs," in Class 7. The application was based on a claim of use of the mark on these products since March of 1992.

The application stated that the mark was used "by applying it to the goods." Two kinds of specimens were submitted with the application. One is a promotional

brochure in which the goods are pictured bearing the mark "DADCO." Page two of the brochure shows a photograph of a guarantee certificate above the words "DADCO Gold Guarantee™." The accompanying text invites prospective purchasers to contact Dadco to learn about the "Gold Guarantee™" for written assurance of the performance life of applicant's gas springs.

The other original specimen is a copy of the warranty certificate which was pictured in the promotional brochure. It is a full-page document with an etched border and a gold seal in the lower right corner. The certificate bears the following heading:

DADCO®
Gold Guarantee™

One Million Strokes

Dadco Limited Warranty

The text under the above wording states that DADCO warrants that each gas spring manufactured by DADCO after January 1, 1994 "shall be free from defects under normal use and maintenance conditions for twenty-four months from the date of sale or one million strokes, whichever occurs first." Further details of the warranty are provided after that. An additional full page of such information is printed on the back of the certificate.

The Examining Attorney refused registration under Sections 1, 2 and 45 of the Lanham Act on the ground that the words sought to be registered do not function as a trademark for the goods specified in the application. He stated that the proposed mark identified the limited warranty for applicant's products, but not the source of the goods.

In addition to issuing the refusal to register, the Examining Attorney required applicant to submit new specimens which show the term sought to be registered used as a trademark for the goods set forth in the application. He also required an amendment to the identification-of-goods clause to specify the industry or field of goods in which applicant's springs are used.

Applicant responded by amending the application to state the goods as "nitrogen gas springs for press tools for the metal stamping industry and the like." The method-of-use clause was amended to delete the reference to use of the mark "by applying it to the goods," and to substitute therefor "on the goods by being placed in displays associated with the goods."

New specimens were submitted, supported by an appropriate declaration as to their use prior to the filing date of the application. The new specimens are photographs of what are described by the declarant, applicant's

treasurer, as "displays associated with the goods." The photos show two of applicant's "Dadco" spring units next to one of the warranty certificates described above. Applicant's treasurer explained that the photos show displays as used by applicant at trade shows in Chicago and Nashville.

The Examining Attorney remained of the opinion that the specimens do not show the term sought to be registered used as a trademark. The refusal to register under Sections 1, 2 and 45 and the requirement for acceptable specimens showing use of the words sought to be registered as a trademark were continued and made final in the second Office Action.

Applicant filed a timely notice of appeal. Both applicant and the Examining Attorney filed briefs, but no oral hearing was requested, so the Board has resolved this proceeding based on the written record and arguments.

Based on careful consideration of these materials, we find that the specimens of record do not show "GOLD GUARANTEE" used as a trademark, i.e., to indicate the source of applicant's gas springs and distinguish them from similar products made or sold by others. We agree with the Examining Attorney that the specimens of record show the words sought to be registered used only in reference to the warranty applicant provides to purchasers of its goods. Applicant has not shown trademark use, and has failed to

meet the requirement for specimens set forth in Section 1(C) of the Act and Trademark Rule 2.56.

It is well settled that in order for a term to be registrable as a trademark for goods it must be used in a manner which projects to purchasers or potential purchasers a single source or origin for the goods in connection with which it is used. "Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark." In re Remington Products Inc., 3 USPQ2d 1714, 1715,(TTAB 1987). The question to be resolved in determining whether a term functions as a trademark is how it will be understood by the relevant purchasing public. In the instant case, the inquiry becomes whether the words "GOLD GUARANTEE" would be perceived as an indication of the source of applicant's nitrogen gas springs, or instead as simply a designation which applicant applies to the warranty it provides in support of its product.

We have no difficulty in concluding that the designation sought to be registered is not perceived as an indication of the origin or source of applicant's springs. The materials of record are very clear that the mark "DADCO," both with and without the design feature shown on the photographs of applicant's springs, serves to indicate the source of these goods, but the words "GOLD GUARANTEE"

are used only in reference to applicant's promise to repair or replace any of its goods which are identified as defective within the period specified on the warranty certificate.

As the Examining Attorney points out, the promise to repair or replace defective products may serve as an inducement to buy particular goods, but ordinarily, simply offering a warranty is not considered to constitute a separate service within the meaning of the Lanham Act, such that a term used in connection with a warranty would be considered to be a service mark. A guarantee is normally expected to be part of what the purchaser gets when he or she buys a product. In re Orion Research, Inc., 523 F.2d 1398, 187 USPQ 485 (CCPA 1975).

Where a manufacturer offers a warranty which is significantly more extensive and beneficial to purchasers than that ordinarily offered by others in the field, the activity encompassed within the warranty has been held to constitute a service. In re Mitsubishi Motor Sales of America, Inc., 11 USPQ2d 1312 (TTAB 1989). We have no indication, however, that the instant case involves such a situation. Applicant has not even argued that its warranty constitutes a service, much less amended the application to reflect that applicant claims use of "GOLD GUARANTEE" in connection with such a service, rather than as a trademark

for the goods themselves. Moreover, even had such an amendment been proffered, from the information of record, it does not appear that applicant's warranty has any of the characteristics it would have to possess in order for the term used to identify it to be considered a service mark.

In summary, because neither the specimens submitted with the application nor the additional ones submitted after the refusal to register was made show the term sought to be registered used as a trademark, that is, to identify the source of applicant's goods and distinguish them from similar products from other sources, the refusal to register under Sections 1, 2 and 45 of the Act is affirmed. In a similar sense, the requirement for specimens which show "GOLD GUARANTEE" used as a trademark on applicant's goods is also affirmed.

J. D. Sams

R. F. Cissel

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial & Appeal Board